



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,511	11/14/2000	David K. Gifford	06543-002006	8013

24573 7590 09/21/2004

BELL, BOYD & LLOYD, LLC  
PO BOX 1135  
CHICAGO, IL 60690-1135

EXAMINER
----------

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
----------	--------------

3623

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/711,511

Applicant(s)

GIFFORD, DAVID K.

Examiner

Susanna M. Diaz

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Final Office action is responsive to Applicant's response filed August 6, 2004.

Claims 1-4 are pending.

2. The previously pending objection to the specification is withdrawn in response to Applicant's amendment of the abstract.

### ***Terminal Disclaimer***

3. The terminal disclaimer filed on August 6, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent Nos. 6,195,649 and 5,724,424 has been reviewed and is accepted, thereby obviating the Double Patenting rejections. The terminal disclaimer has been recorded.

### ***Response to Arguments***

4. Applicant's arguments filed August 6, 2004 have been fully considered but they are not persuasive.

Applicant argues:

...According to claims 1 and 4 the purchase message communicated from the purchase means is sent to the merchant computer. In Bush, however, a menu is broadcast from transmitting source 10 (transmitting source may or may not be a merchant computer, but more likely it is a video broadcast source) when a user desires to buy a product or

service listed on the menu transaction data and user credit card information are sent to a separate transaction processor 30. This information would be sent by a modem through a telephone line (col. 3, l. 29). This is a communication channel separate and distinct from the broadcast channel that delivered the menu to user terminal, and it delivers the purchase message to a different destination from the source of the digital advertisements (menu). (Page 3 of Applicant's response)

The claims do not specify direct transmission from one particular computer to another. For example, even though Bush's consumer may receive a cable programming or services menu (i.e., digital advertisements) from a transmitting source (col. 1, lines 59-67) and make a menu selection that is transmitted to a transaction processor (col. 2, lines 1-20), the vendor (i.e., the merchant) is the primary source of these digital advertisements (see at least Fig. 1-A) and the vendor eventually receives transaction information from the transaction processor as well (see at least Fig. 1-A and col. 3, lines 50-52). It is the receipt of the transaction information from the transaction processor that triggers the vendor to provide the requested service or goods to the consumer (col. 3, lines 52-54). Furthermore, claim 1 recites "at least one merchant computer" and makes reference to the "at least one merchant computer" using the phrases "each merchant computer" or "said merchant computer." As long as a computer functions in conjunction with or on behalf of a merchant, it may be interpreted as one of several "at least one merchant computer" and "said merchant computer" may refer to any one of these "at least one merchant computer." Since the vendor, transaction processor, and transmitting source are all linked to one another as part of the Transactional Processing System (TPS) (Fig. 1-A) and can be seen as functioning

in conjunction with and on behalf of a merchant, the integration of these computers may be reasonably interpreted, either individually or collectively, as "at least one merchant computer." Therefore, the Examiner maintains that Bush indeed discloses a merchant computer that transmits digital advertisements and receives payment messages, albeit through various linked merchant computers (which addresses the claimed invention recited in both claims 1 and 4).

In summary, the Examiner deems Applicant's arguments to be non-persuasive and the art rejection is maintained.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Bush (U.S. Patent No. 5,475,585).

Bush discloses a network sales system comprising:

[Claim 1] a plurality of buyer computers and at least one merchant computer interconnected by a communications network (col. 1, lines 8-27, 56-59 -- Bush's

Art Unit: 3623

invention is targeted to customers of cable TV, thereby implying that multiple cable customers may access Bush's service via cable transmission; Fig. 1A),

means at each merchant computer for maintaining and providing a database of digital advertisements (Fig. 1A; col. 3, lines 1-20; col. 5, lines 10-19) comprising:

means for storing said digital advertisements, each digital advertisement including a product abstract (Figs. 1A-5, 8; col. 3, lines 52-54; col. 8, lines 3-8 -- The electronically communicated and displayed menu of various artists performing in a selected location is indicative of a database of digital advertisements with corresponding instructions that are programmed to cause the advertisements to be displayed. Also, a brief description, i.e., an abstract, of various products and services may be advertised to a customer),

means for communicating a digital advertisement to a buyer computer over said network in response to a network request from said buyer computer (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8),

means at each buyer computer for requesting, displaying, and responding to digital advertisements (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8) comprising:

means responsive to a user inquiry for selecting a merchant computer and obtaining a digital advertisement for a product from said database of advertisements at said merchant computer (Figs. 1A-5, 8; col. 3, lines 1-20; col. 4, line 67 through col. 5, line 23; col. 8, lines 3-8),

display means for displaying said advertisement (col. 3, lines 1-20; col. 8, lines 3-16),

purchase means responsive to a user request for communicating a purchase message to said merchant computer (Figs. 1A-5, 8; col. 3, lines 50-54; col. 4, line 67 through col. 5, line 23; col. 8, lines 3-16),

account identification means to authorize said purchase message by sending messages into a financial system network (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48),

means, at said merchant computer, comprising:

authorization means to authorize said purchase message by sending messages into a financial system network (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 4, line 67 through col. 5, line 23; col. 6, lines 46-48 -- In one scenario, the merchant computer must submit transaction information to the financial system network in order to provide a cross-check before the financial transaction is verified, as explained in detail in col. 3, line 60 through col. 4, line 10),

fulfillment means to send said product to user conditional on approval of said authorization means (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48; col. 8, lines 13-16, 30-42 -- Ordered tickets or software are delivered to the user after processing payment);

[Claim 3] wherein said account identification means comprises:

means for assembling a payment order (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48),

means for sending said payment order to a network payment system for authorization (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48),

and wherein said authorization means comprises:

means for verifying that said payment order has been previously authorized by said payment system (Fig. 1A; col. 3, line 21 through col. 4, line 10; col. 6, lines 46-48).

Bush discloses an electronic sales system comprising:

[Claim 4] means for storing a database of digital advertisements, each digital advertisement for a product including a program (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8 -- The electronically communicated and displayed menu of various artists performing in a selected location is indicative of a database of digital advertisements with corresponding instructions that are programmed to cause the advertisements to be displayed),

means for communicating a digital advertisement to a buyer computer (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8),

means at said buyer computer for displaying and responding to said digital advertisement (Figs. 1A-5, 8; col. 3, lines 1-20; col. 8, lines 3-8) comprising:

display means for displaying said digital advertisement by executing a portion of said advertisement as a program and performing actions as specified by said program (col. 3, lines 1-10; col. 8, lines 3-16),

purchase means responsive to a user request for communicating a purchase message to a merchant computer (Figs. 1A-5, 8; col. 4, line 67 through col. 5, line 23; col. 8, lines 3-16),



means, at said merchant computer, comprising:

fulfillment means to send said product to said user (col. 3, lines 52-54; col. 8, lines 13-16, 30-42 -- Ordered tickets or software are delivered to the user after processing payment).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bush (U.S. Patent No. 5,475,585), as applied to claim 1 above.

[Claim 2] Bush discloses an authorization means at the merchant computer (as discussed in the rejection of claim 1 above); however, Bush does not expressly teach the details of what occurs if it is determined that certain payment information is missing. Official Notice is taken that it is old and well-known in the art of financial transactions to request additional information if needed to complete a financial transaction. For example, Bush specifically addresses credit card transactions and it is old and well-known to request additional credit card information when needed. This additional information may include a credit card holder's address, security code, name as exactly printed on the credit card, etc. The request for additional information during a credit card transaction provides added security for the transaction (e.g., verification that the

card has not been stolen or is not being used by someone not in possession of the actual card). The limitations of claim 2 are merely directed toward the means for electronically performing such a request for missing information; therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Bush's electronic credit card authorization means to incorporate means for communicating a missing payment information request message to said buyer computer to obtain missing payment information, means for receiving said missing payment information from said buyer computer, means for authorizing said purchase message by sending messages into a financial system network, wherein said account identification means at said buyer computer comprises means responsive to said missing payment information request message to query the user for additional payment information and means to send said additional payment information to said merchant computer in order to facilitate the quick and efficient retrieval of additional information needed to complete a credit card transaction, thereby providing added security for the transaction (e.g., verification that the card has not been stolen or is not being used by someone not in possession of the actual card).

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 3623

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450**

or faxed to:

**(703) 872-9306** [Official communications; including  
After Final communications labeled  
"Box AF"]


**(703)746-7048** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Application/Control Number: 09/711,511

Page 11

Art Unit: 3623

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7<sup>th</sup> floor receptionist.



Susanna M. Diaz  
Primary Examiner  
Art Unit 3623  
September 16, 2004